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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/359,809
Filing Date: July 23, 1999
Appellant(s): LEVY, RICHARD

Robert J. Eichelburg
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 4, 2007 appealing from the Office action mailed May 24, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Patent Applications 08/943,125; 10/614,114; and 09/357,957

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 7338926 (U.S. Patent Application 10/781,240).

Claims 73-100 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 57-63, 65-71, 73, 76, and 87-91 of copending Application No. 10/614,114.

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 89 under 35 U.S.C. 112, first paragraph.

The obviousness-type double patenting rejection over formerly copending U.S. Application No. 10/763,687 is withdrawn in view of that application being abandoned.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,792,717	TAKAYAMA	08-1998
5,275,760	JOHNSON	01-1994
4,340,706	OBAYASHI et al	07-1982
7,338,926	LEVY	03-2008

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 1797

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 73-100 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 7,338,926 (Application No. 10/781,240). Although the conflicting claims are not identical, they are not patentably distinct from each other because the lubricant composition of the present invention is the same composition used in the now patented method of lubricating a surface. Therefore, it would have been reasonable to expect that the lubricant composition of the present invention would have been used to lubricate a surface.

Claims 73-100 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 57-63, 65-71, 73, 76, and 87-91 of copending Application No. 10/614,114. Although the conflicting claims are not identical, they are not patentably distinct from each other because while the present claims do not contain a substrate, it would be reasonable to expect that the lubricant composition would have been applied to a substrate, such as in the copending

application, given the fact that lubricants are applied to substrates to protect the substrates.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 73, 74, 76, 77 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takayama (US 5,792,717).

Takayama teaches a sliding material comprising a porous ceramic body that has open pores filled with a high water absorbing resin (see abstract). The ceramic body may be boron nitride and the resin may be crosslinked polyacrylates (see col. 4, lines 4-11; col. 5, lines 16-28). The resin absorbs at least 100 times its weight in water (see col. 4, lines 60-67). Takayama teaches that the composition has lubricity properties (see col. 4, lines 30-43).

Takayama fails to teach that the boron nitride (BN) remains in particulate form. However, Takayama does teach that the reference starts out with BN particles that are 10 micrometer or less and that these particles are shaped into ceramic bodies (col. 4,

lines 12-18 and Fig. 1). The ceramic bodies in combination with the superabsorbent polymers still function as a lubricating material.

Claims 73-76, 80-82, 86, 87, 89-93, 96, 99 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 5,275,760) in view of Obayashi et al. (Obayashi, US 4,340,706).

Johnson teaches a gelled corrosion inhibitor comprising a gelling agent slurried in a first medium and a corrosion inhibitor dissolved in a second liquid medium, wherein the gelling agent forms a gel in the second liquid medium (see abstract; col. 3, lines 3-7). The gelling agents are water insoluble hydrogel-forming materials known in the art as superabsorbent polymers(see col. 3, lines 21-23, 31-68). The gelling agents are carried as a slurry in an oil such as fatty esters, mineral oils and lubricating oils (first medium). The corrosion inhibitor (lubricant additive) is dissolved in water (see col. 4, lines 39-55). The corrosion inhibitor may be alkali or alkaline earth metal carbonate (applicant's carbonate) (see col. 4, lines 44-48). Johnson teaches the limitations of the claims other than the differences that are discussed below.

In the first aspect, Johnson differs from the claims in that appellant's intended use is not specifically taught. However, intended use is given little patentable weight in claims that are directed to the composition per se.

In the second aspect, Johnson differs from the claims in that the super absorbent polymer absorbs greater than 100 times its weight in water is not taught. However, Obayashi teaches this difference. Obayashi teaches that the cross-linked neutralized

polyacrylic acid taught by Johnson absorbs at least 400-800 times its weight in water (see abstract; col. 6, lines 42-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed polymers because Johnson teaches the use of superabsorbent polymers and Obayashi teaches that these polymers absorb greater than 100 times their weight in water.

In the third aspect, Johnson differs from the claims in that the oils are polymerized olefins is not taught. However, no unobviousness is seen in this difference because Johnson teaches that hydrocarbon oils may be used in the invention and this broad teaching suggests polymerized olefins, which are hydrocarbon oils.

(10) Response to Argument

With respect to the double patenting rejection, Appellant argues that since neither of the copending applications have issued, Appellant requests allowance of the present application, or if one or both of the copending applications issue as a patent, Appellant reserves the right to distinguish the claims in the present application from the claims of the issued application or copending application.

Appellant's request is noted. However, at the present time, there are two applications pending, and two rejections under 35 U.S.C. 103(a) in the present application. Since the provisional obviousness-type double patenting rejection is not the only rejection remaining in the present application, it is proper to maintain that rejection under the present circumstances. See MPEP 804 (I) (B).

Appellant argues that the monolithic boron nitride ceramic body of Takayama is not Appellant's particulate boron nitride. Appellant argues that to apply Takayama to reject the present claims would require taking the Takayama article and using it to lubricate a substrate. Appellant argues that Takayama is silent with respect to the lubricity properties of the combination of the monolithic boron nitride and the superabsorbent polymer.

In regards to Takayama not teaching Appellant's particulate boron nitride, Appellant does not appear to teach a specific boron nitride, so therefore, there does not appear to be any difference between the boron nitride taught by Takayama as compared to Appellant's. Furthermore, Takayama teaches initially using ceramic powder having an average particle size of 10 micrometers. The ceramic powder is then taken and formed into the ceramic body from this material, and, after this, the pores of the ceramic body are filled with the superabsorbent polymer. Appellant's claims have been given their broadest interpretation, and it is the examiner's position that Takayama renders obvious the claimed process for manufacturing a lubricant composition and the lubricant composition. The claims are open to particulate material that may be measured in micrometers as well as particulates that may be measured in millimeters. Appellant has not made a distinction. Furthermore, the term particulate not only defines particles but also materials made from those particles.

Takayama teaches that the prior art porous ceramic bodies are poor in self-lubricating properties, and in order to use them in sliding materials, they are lubricated with highly viscous oils or composites with solid lubricants. Takayama teaches that the

sliding material exhibit good self-lubricating properties (see col. 2, lines 30-34 and 54-61). Therefore, Takayama does teach that sliding materials have lubricity properties.

Appellant is of the opinion that in order for a material to be used as a lubricant that the material must be applied to a substrate. The examiner respectfully disagrees. Lubricants may be compositions which serve to lubricate solid surfaces, but they also may be solid antifriction devices or articles described in terms of their chemical composition as well as materials from which said solid antifriction devices or articles are fashioned. Takayama clearly teaches lubricant compositions that encompass those of the present invention.

Appellant argues that Johnson bears no chemical resemblance to the claim 73 inorganic lubricating materials, silicate ester, polyphenyl ether, organic phosphate, biphenyl, phenanthrene or phthalocyanine, but instead uses oils as the lubricant with the superabsorbent polymer.

The examiner respectfully disagrees. Johnson teaches a second liquid medium comprising carbonates of alkali or alkaline earth metals (see col. 4, lines 39-49). These compounds read on the claimed lubricating metal carbonate. If the carbonates have lubricity properties in the claimed invention, then one skilled in the art would have reasonably expected that the carbonates would have lubricity properties in the composition of Johnson.

Art Unit: 1797

(11) Related Proceeding(s) Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided herein.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

//Cephia D. Toomer//

Primary Examiner, Art Unit 1797

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